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Supreme Court of the United States

OCTOBER TERM, 1954

No. [redacted]348

SPECIALTIES DEVELOPMENT CORPORATION,
Respondent,

v.

RANDOLPH LABORATORIES, INC.,
Cross-Petitioner.

BRIEF FOR RESPONDENT IN OPPOSITION TO CROSS-PETITION FOR CERTIORARI

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Randolph's First Question Presented

The first question presented by Randolph, and the statement preceding it, are inaccurate as to facts. No references to the record are given in support of any of the inaccurate statements of fact.

The correct facts are as follows:

Randolph was incorporated and began business January 1, 1942 (No. 281,* D-26a).

Prior to its start of business it was offered a license under the Minor patent (No. 281,* P-26a).

In April, 1945, the offer of a license under the Minor patent was repeated (No. 281,* P-22a).

* October Term, 1954, No. 281.

On April 30, 1945 Randolph started the present action for declaratory judgment of invalidity of the Minor patent (No. 281,* P-1a).

Specialties counterclaimed for infringement of the Minor patent, the Mapes patent, and two others (No. 281,* P-6a).

Randolph now asserts in its first question that Specialties was estopped from filing the compulsory counterclaim for infringement of the Mapes patent because it did not previously charge Randolph with infringement of this patent or offer Randolph a license under it.

Throughout the trial and throughout the accounting proceeding Randolph asserted that all of its production during the war was for the government (P-246a), so it could not be sued for infringement. Randolph now reverses its field and asserts that Specialties should have known all along that this assertion was false, and that Randolph was open to an infringement suit, and that therefore Specialties is estopped.

In view of the complete absence of any factual or legal basis for any estoppel we believe no argument is necessary. The Court below said, as quoted on page 7 of the Cross-Petition:

> "We see no merit whatever in this contention since no basis for an estoppel was established."

Randolph's Second Question Presented

The second question presented assumes as a fact, and asks this Court to accept as a fact, that the Fyre-Freez valve anticipated claim 16 of the Mapes Reissue patent. This is not a fact. The fact is that Randolph has argued

* October Term, 1954, No. 281.

such anticipation before the Courts 8 times in this case, always without success. Its bald assertion that this is a fact is presumptuous, to put it mildly.

Randolph argued invalidity of the Mapes patent over the Fyre-Freez valve at the trial (No. 601,* R. 17-19, ¶1 to 4), on rehearing before the Trial Court (No. 601,* R. 19-20, ¶5, 6), on appeal from the interlocutory judgment (No. 601,* R. 20-22, ¶7-10), on petition for certiorari to this Court in No. 698, October Term 1949 (No. 601,* R. 22-24, ¶11), and on a second appeal to the Court of Appeals (No. 601,* R. 24-25, ¶12 to 13). Five years after the trial it sought leave in the Court of Appeals to reopen on the identical argument of invalidity, changing the name of the defense to fraud on the Patent Office (No. 601,* R. 1-14), and followed that with a second petition to reopen in the Court of Appeals on the same ground (No. 601,* R. 33-42), and a second petition for certiorari in this Court, No. 601.* It now for the third time asks this Court to grant certiorari, with the bald factual statement that the facts are directly contrary to the repeated holdings of the Courts in this case.

On the issue of anticipation under the name of fraud the Court of Appeals, preceding Randolph's petition to this Court in No. 601,* said at No. 281,** P-287 A:

> "It thus appears that the structure which the plaintiff now asserts to be a complete anticipation of claim 16 was disclosed to the patent office at the time the Mapes application was filed and was accurately described by Mapes to the district court."

On the same page the Court said:

> "The defendants strongly urge that * * * by its present petition the plaintiff is seeking by charging

* October Term, 1952, No. 601 in this Court.
** October Term, 1954, No. 281.

> fraud to secure a rehearing of an issue which has already been fully heard and decided against it. We think that there is much justification for the defendants so characterizing the plaintiff's present application."

The Court continued on P-288a:

> "Nonetheless if we thought that there was any probability that Mapes or his assignee, defendant Walter Kidde and Company, Incorporated, had been guilty of fraud in procuring the allowance of claim 16 we would not hestitate to grant the plaintiff the leave which it now requests. We are fully satisfied, however, for the reasons which will be stated that the Fyre-Freez valve did not anticipate the subject matter of claim 16, properly understood, * * *."

It was following that decision that this Court denied certiorari in No. 601, October Term, 1952.

The second question presented was not presented to the Court below on the present appeal in view of the fact that that Court had decided that question adversely to Randolph three times previously in this case, and this Court had twice previously denied certiorari.

CONCLUSION

It is accordingly prayed that Randolph's cross-petition for certiorari be denied.

Respectfully submitted,

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New York, New York,
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